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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,382	04/01/2004	Larry G. Ingraham	15998.0023	8271
36734 7590 05/27/2009 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304				
EXAMINER				
DAVIS, CASSANDRA HOPE				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/815,382

**Applicant(s)**

INGRAHAM, LARRY G.

**Examiner**

Cassandra Davis

**Art Unit**

3611

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-18 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18 and 20-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Nemzin et al., US 5223316.

3. Nemzin teaches a support frame for predetermined characters comprising a 3-D element 12 having a hanger tab 30 for permanently securing the support frame to a wall, a signage donor element 26 and 24. The support frame and the donor elements are made from the same resilient plastic material and are colors contrasting so that the characters can be easily distinguished from the associate holders.

4. The hanger tab 30 corresponds to "a mounting surface of said base element being configured to be securely mounted to an area where a wall meets a floor..." The hanger tab 30 provides a means to mount the support frame to a wall wherein the support frame is adjacent the corner of a wall and floor. The applicant does not positively recite that the base element is secured to both the wall and the floor.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-16, 20, 21, 23, 24, and 32 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Studen U. S. Patent 3,280,499 in view of Nemzin et al., U. S. Patent 5,223,316.

3. Studen teaches a device comprising a three-dimensioned element defining a signage recipient base element (blank 2) and a plurality of signage donor element (portions 14-22), wherein the base element has a plurality of apertures 5-13. The base 2 and donor elements 14-22 are constructed of expanded polyethylene such that the donor element frictionally fit with the apertures 5-13 of the base 2. The friction fit corresponds to the claimed snap-in fit. The donor element has a color different than the color of the base. See column 1, lines 48-55. Nemzin teaches a support frame for predetermined characters comprising a 3-D element 12 having a hanger tab 30 for adhering the support frame to a wall, a signage donor element 26 and 24. The support frame and the donor elements are made from the same resilient plastic material and are colors contrasting so that the characters can be easily distinguished from the associate holders. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Studen with a support tab-type holder as taught by Nemzin to provide means to support the device upon a wall.

4. The hanger tab 30 corresponds to "a mounting surface of said base element being configured to be secureably mounted to an area where a wall meets a floor..."

The hanger tab 30 provides a means to mount the support frame to a wall wherein the

support frame is adjacent the corner of a wall and floor. The applicant does not positively recite that the base element is secured to both the wall and the floor.

5. With respect to claim 13, Studen teaches the donor element comprises a plurality of sub-parts (each indivisible punched portion 5-13 and the stencil-like portion or apertures comprises a plurality of separate sub-portions 14-22, with each sub-portion or aperture of the base element having inserted therein one of the donor element sub-parts.

6. With respect to claim 14-16, Studen teaches the color of the donor elements is different than the base element.

7. With respect to claims 20, 21, 23, 34, since the specific indicia does not have an unobvious functional relationship with the signage donor element, it appears that any suitable indicia/indication/message would perform equally well in conveying a desired message.

8. With respect to claim 32, since the applicant does not positively claim base element and the overlapping portion with respect to the wall and the floor, claim 32 is rejection over Studen in view of Nemzin.

9. Claims 17 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Studen in view of Nemzin as applied to claim 12 above and in view of Forbes et al., U. S. Patent 6,626,678. Forbes et al teaches a base 42, a frame 43 secured to the base and having a plurality of apertures and a plurality of tiles 44 adapted to fit within the apertures. Each tile has a layer of soft fabric with different tactility. Forbes also teaches that each tile is distinguishable by color or by the presence of indicia on the textured

surfaces. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Studen and Nemzin with each donor element further be distinguishable by tactility, color, or indicia to provide a means identify one donor or tile element from another.

10. With respect to claims 29-31, since the applicant does not disclose that indicia with phosphorescent, glitter, or photo-luminescent solves any stated problem or is for any particular purpose, it appears that constructing the indicia with any suitable material which contrast with the base or support surface would perform equally well in conveying a desired message.

11. Claim 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Studen U. S. Patent 3,280,499 in view of Nemzin et al. as applied to claim 12 above and in further view of Wright, U. S. Patent 2,535,619.

12. Wright teaches a toy comprising a base member 10 having a plurality of cutouts and a plurality of donor element or segments 11, wherein each segment has a different thickness than the base member. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Studen and Nemzin with segment having different thicknesses than the base as taught by Wright to provide a means to enhance the aesthetic appearance of the device.

### ***Response to Arguments***

1. With respect to the rejection of claims 25-28 under 35 U.S.C. 102(b) as being anticipated by Nemzin et al., US Patent 5223316, the applicant argues Nemzin does not disclose a wall base and thus does not anticipate the invention defined in claim 25. The

applicant further argues the "preamble limits the claimed invention to structural material that can be used as wall base."

2. Although the applicant argues that the term "wall base" in the preamble has a generally accepted meaning in the building, flooring and carpeting art, the examiner maintains that the claimed structure does not preclude the devices taught by Nemzin from reading on the claimed invention. ". The examiner contents that the devices taught by Nemzin and Studen are **adapted** to be secured to a wall and an overlaying portion of a floor.

3. With respect to the rejection of claims 12 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Studen, US Patent 3280499 in view of Nemzin.

4. The applicant argues neither Studen or Nemzin teaches "wall base" nor recites "a three dimensioned element which defines a signage recipient base element adapted to be secured to an area where a wall meets a floor in a joint including a mounting surface adapted to secure to the wall and an overlaying portion adapted to overlap and secure to a portion of the floor so that the area where the wall meets the floor is hidden behind a length of said three dimensioned element when said three dimensioned element is securely mounted to the area where the wall meets the floor," The examiner disagrees. Claim 12 merely recites "a three dimensioned element... including a mounting surface **adapted** to secure to a wall and an overlaying portion **adapted** to overlap a portion of a floor so that the area where the wall meets the floor is hidden behind a length of the three dimensioned element **when** the three dimensioned element is securely mounted to the area where the wall meets the floor". The examiner

contents that the devices taught by Nemzin and Studen are **adapted** to be secured to a wall and an overlaying portion of a floor. The examiner suggest positively claiming the floor and the wall in combination with the "wall base" or claiming the wall base in a method of use type claim wherein the environment in which the device is used is given more weight.

5. The applicant further argues children's games have no relationship to the field of wall base, which has an accepted meaning in the building, flooring, and carpeting industries (page 5, lines 11-16). Since the applicant does not positively claim the wall base in combination with the floor and wall, the examiner maintains that the device taught by Studen and Nemzin are adapted to be attached/secured to the area where a wall meets a floor and overlap a portion of a floor.

6. The rejection is maintained.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 571-272-6642. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cassandra Davis/  
Primary Examiner  
Art Unit 3611